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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,589	04/30/2001	Dale F. McIntyre	82466RLO	2441

7590 05/14/2003  
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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/14/2003

*15 Remailed*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/845,589

Applicant(s)

MCINTYRE ET AL.

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 8, 10-15, 17, 18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8, 10-15, 17, 18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-6, 8, 10-15, 17, 18 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. ('220) in view of Fink (6,544,037) and further in view of Monn (5,712,005).

Huang et al. disclose a method of arranging a series of at least two visual images of different characteristics of the same image comprising using a photographic digital image of the same image to produce a series of digital images of different characteristics and forming the images on a single photographic print medium (see figure 2 and col. 4, lines 39-58). Regarding each image having different characteristics, Huang et al. discloses that all of the sketches can be of different sizes (as seen in col. 4, lines 56-58).

Huang et al. disclose the claimed invention except for forming a visual image of printed instructions for making the scrapbook on the single photographic print medium.

Fink discloses a picture pad (12) including rectangular sheets (18) imprinted with instructions and images (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Huang's

invention to include instructions of any desired content imprinted thereon, as taught by Fink, to provide the user with a guide for arranging the digital images.

Huang et al. disclose the claimed invention except for manually cutting out the images and manually fixing the cut out images on a page.

Monn discloses a kit (10) for decorating a photo album storage box (14) with color photocopies of photographs from a photo album (12) comprising an instruction sheet (20) including printed instructions for providing a color photocopy of a color photograph, tearing the edges of the photocopy, applying adhesive to the front and back sides of the photocopy and pasting the photocopy to the outside surface of the box (see col. 3, lines 48-55 and figures 2-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Huang's invention to include manually cutting and fixing the images on a page, as taught by Monn, for providing a decorative appearance for boxes, sheets of paper or the like.

Regarding claim 3, Huang et al., as modified by Fink and Monn, disclose the characteristic including different sizes (see figure 2 of Huang et al.).

Regarding claim 4, see the above rejections to claim 1.

Regarding claim 5, Huang et al., as modified by Fink and Monn, disclose the images being photographic images.

Regarding claim 6, Huang et al., as modified by Fink and Monn, disclose the cut out images being fixed by using an adhesive (see Monn, col. 3, lines 48-52).

Regarding claim 8, see the above rejections to claim 1, wherein the annotated information is considered being the instructions printed on the sheet as set forth above.

Regarding claim 10-13, see the above rejections.

Regarding claim 14, the other visual images are considered to be the instructions printed on the sheet as set forth above.

Regarding claims 15, 17, 18 and 23-25, see the above rejections to claim 1.

3. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. in view of Fink and Monn, as used above, and further in view of Morag ('545).

Huang et al., as modified by Fink and Monn, disclose the claimed invention except for an instruction sheet providing information including text and images in digital format over a communication channel to a service provider.

Morag discloses a method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Huang's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 3-6, 8, 10-15, 17, 18 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

May 12, 2003

*Monica S. Carter*  
**MONICA CARTER**  
**PATENT EXAMINER**